Remarks

The preceding amendments and following remarks are submitted in response to the Final Official Action of the Examiner mailed May 1, 2007, setting a three-month shortened statutory period for response ending August 1, 2007. Claims 1, 3-17, and 21-32 remain pending. Reconsideration, examination and allowance of all pending claims are respectfully requested.

Entry of this Amendment-After-Final Requested

Applicant respectfully requests entry of this Amendment-After-Final because only minor amendments have been made to the claims and, at the very least, it places the case in better condition for appeal.

Interview

The undersigned would like to thank the Examiner for the courtesies extended during the telephone interview of June 28, 2007. A proposed Amendment-After-Final similar to but not identical to this Amendment-After-Final was discussed. No agreement was reached.

Allowable Subject Matter

In paragraph 34 of the Final Office Action, the Examiner states that claims 26-31 are allowed. In paragraph 35 of the Final Office Action, the Examiner states that claim 22 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Double Patenting

In paragraph 2 of the Final Office Action, the Examiner rejected claims 15-17 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,921,184 to TUFTE. The Examiner states that although the conflicting claims are not identical, they are not patentably distinct.

Applicant respectfully disagrees that claims 15-17 are not patentably distinct from claim 1 of TUFTE. Claim 1 of TUFTE recites:

> 1. An elongated light for receiving an elongated light source, comprising:
>
> an elongated member having a cavity for receiving the elongated light source and an elongated slit that extends into the cavity through the elongated member, wherein at least part of the cavity is defined by an at least semi-transparent material that extends from the cavity to an outer surface of the elongated member;
>
> an elongated carrier, the elongated carrier having a back side and two side walls, wherein the side walls define a slot that is spaced from the back side of the carrier for receiving at least part of the elongated member, the elongated member having a back portion that faces the back side of the elongated carrier when the elongated member is received by the slot, and the elongated slit of the elongated member extends into the cavity of the elongated member through the back portion of the elongated member; and
>
> wherein the slot is sized so that at least part of the elongated member must be forcibly inserted into the slot and, once inserted, the side walls of the elongated carrier forcing the slit or opening of the elongated member into a closed or substantially closed position.

In contrast, claim 15 recites:

> 15. (previously presented) An elongated bumper, comprising:
>
> an elongated light source having a round or substantially round cross-section;
>
> an elongated bumper member having a light receiving cavity or lumen extending lengthwise for receiving the elongated light source; and
>
> the light receiving cavity or lumen defined by a cavity or lumen wall that, in cross-section, has a round or substantially round shape that spans at least 180 degrees and is sized so that the elongated light source fills or substantially fills the light receiving cavity or lumen as defined by the cavity or lumen wall.

As can readily be seen, claim 1 of TUFTE does not recite many of the elements of claim 15 of the present application including, for example: (1) an elongated light source having a round or substantially round cross-section; or (2) a light receiving cavity or lumen defined by a cavity or lumen wall that, in cross-section, has a round or substantially round shape that spans at least 180

degrees and is sized so that the elongated light source fills or substantially fills the light receiving cavity or lumen as defined by the cavity or lumen wall. The Examiner appears to acknowledge these differences. However, the Examiner states where the only difference between the prior art and the claims is a recitation of specific shape and/or relative dimensions of the claimed device, and a device having the claimed shape or relative dimensions would not perform differently than the prior art device, the claimed device is not patentable distinct from the prior art device (citing *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966); and *In Gardner v. TEC Systems, Inc.*, 220 USPQ 777 (Fed. Cir. 1984) (emphasis added).

The described shape and configuration recited in claim 15 are not merely ornamental in nature, as the Examiner appears to be suggesting, but rather are significant in that they provide additional functionality. Claim 15 recites an elongated light source that has a round or substantially round cross-section, and a light receiving cavity or lumen defined by a cavity or lumen wall that, in cross-section, has a round or substantially round shape. That is, the light source and the light receiving cavity or lumen have the same or substantially same shape. Claim 15 also recites that the light receiving cavity or lumen wall spans at least 180 degrees and is sized so that the elongated light source fills or substantially fills the light receiving cavity or lumen as defined by the cavity or lumen wall. *Since the light receiving cavity or lumen wall has a round or substantially round shape, spans at least 180 degrees, and is sized so that the elongated light source fills or substantially fills the light receiving cavity or lumen, the elongated light source will be held within the light receiving cavity or lumen by the recited structure. Thus, the recited structure of claim 15 provides functionality that is not necessarily present in claim 1 of TUFTE.*

Certainly, it cannot readily be argued that the only difference between claim 1 of TUFTE and claim 15 is a recitation of a specific shape and/or relative dimension, or that a device having the claimed configuration would not perform differently than that recited in claim 1 of TUFTE (As per *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966); and *In Gardner v. TEC Systems, Inc.*, 220 USPQ 777 (Fed. Cir. 1984)). For these and other reasons, Applicant respectfully requests that the obviousness-type double patenting rejection of claims 15-17 be

withdrawn.

Rejections Under 35 U.S.C. § 102

In paragraph 6 of the Final Office Action, the Examiner rejected claims 12-14 under 35 U.S.C. § 102(b) as being anticipated by Gagne (U.S. Patent No. 5,499,170). Applicant respectfully traverses this rejection. Claim 12, as amended, recites

> 12. (currently amended) A rub-rail assembly, comprising:
> a carrier having a back support, a first leg and a second leg, wherein the first leg and the second leg extend from the back support to form a cavity, the carrier further having a light receiving cavity or lumen defined by side walls for receiving an elongated light source; and
> an insert having a main body, a first leg and a second leg, the first leg adapted to engage the first leg of the carrier and the second leg adapted engage the second leg of the carrier when the insert is installed in a seat position with the carrier;
> wherein the side walls of the light receiving cavity or lumen extend at least partially around to ~~are configured to~~ retain the elongated light source in place relative to the carrier even when the insert is separated from the carrier.

As can be seen, claim 12 recites that the side walls of the light receiving cavity or lumen extend at least partially around to retain the elongated light source in place relative to the carrier even when the insert is separated from the carrier. Gagne clearly does not teach, disclose or suggest a carrier having a light receiving cavity or lumen, wherein the side walls of the of the light receiving cavity or lumen extend at least partially around to retain the elongated light source in place relative to the carrier even when the insert is separated from the carrier. The Examiner equates the carrier of claim 12 with the receptacle 50 of Gagne, and the light receiving cavity or lumen of claim 12 with the recess 65. However, the side walls of recess 65 of Gagne do not extend at least partially around to "retain the elongated light source in place relative to the carrier even when the insert is separated from the carrier", as recited in claim 12. Instead, and as acknowledged by the Examiner, Gagne teach to retain the elongated light source relative to the receptacle 50 using double sided tape 51, particularly when the protective top cover 70 is

separated from the receptacle 50. For example, Gagne state:

> The receptacle 50 also has a recess 65 formed in the raised central portion 57, with the said recess 65 being shaped and dimensioned to receive an electroluminescent lighting element 90 therein. The electroluminescent lighting element 90 is thereby disposed between the receptacle 50 and the protective top cover 70, and is retained in place by way of double sided tape 51.

(Emphasis Added) (Gagne, column 5, lines 1-7). As can readily be seen from Figures 1-2 of Gagne, the side walls of recess 65 of Gagne do not extend at least partially around to "retain the elongated light source in place relative to the carrier even when the insert is separated from the carrier", as recited in claim 12. Instead, and as indicated above, Gagne teach to retain the elongated light source relative to the receptacle 50 using double sided tape 51. For these as well as other reasons, claim 12 and dependent claims 13-14 are believed to be clearly patentable over Gagne.

In paragraph 8 of the Final Office Action, the Examiner rejected claim 15 under 35 U.S.C. § 102(b) as being anticipated by BURKITT, III et al. Applicant respectfully traverses this rejection. Claim 15 recites:

> 15. (previously presented)An elongated bumper, comprising:
> an elongated light source having a round or substantially round cross-section;
> an elongated bumper member having a light receiving cavity or lumen extending lengthwise for receiving the elongated light source; and
> the light receiving cavity or lumen defined by a cavity or lumen wall that, in cross-section, has a round or substantially round shape that spans at least 180 degrees and is sized so that the elongated light source fills or substantially fills the light receiving cavity or lumen as defined by the cavity or lumen wall.

As can be seen, claim 15 recites an elongated bumper that includes: an elongated light source that has a round or substantially round cross-section; an elongated bumper member having a light receiving cavity or lumen extending lengthwise for receiving the elongated light source; and the light receiving cavity or lumen defined by a cavity or lumen wall that, in cross-section, has a round or substantially round shape that spans at least 180 degrees and is sized so that the elongated light source fills or substantially fills the light receiving cavity or lumen as defined by

the cavity or lumen wall.

BURKITT, III et al. does not appear to teach, disclose or suggest such an elongated bumper. For example, and as shown in Figure 2 of BURKITT, III et al., the bundle of fiber optic 12 clearly does not fill or substantially fill the internal longitudinal passageway 28. Instead, the bundle of fiber optic 12 appears to only occupy about 55% of the cross-sectional area of the internal longitudinal passageway 28 (the radius of the bundled fiber optic, which is about 20 mm in Figure 2 of BURKITT, III et al., squared = 400 mm^2, divided by the radius of the internal longitudinal passageway 28, which is about 27 mm, squared = 729 mm^2, resulting in the bundled fiber optic occupying only about 55% of the cross-sectional area of the internal longitudinal passageway 28). Under any reasonable interpretation, the bundled fiber optic 12 cannot be considered to fill or substantially fill the internal longitudinal passageway 28.

In paragraph 48 of the Final Office Action, the Examiner directs the Applicant's attention to Figure 1 of BURKITT, III et al., where the Examiner asserts the elongated light source 12 is clearly shown filling or substantially filling the light receiving cavity or lumen 28. The Examiner states that it appears that Applicant mistakenly took BURKITT, III et al. exemplary showing of **some** of the optical fibers forming the **whole** of the elongated light source 12, as showing the true shape of such elongated light source.

Applicant does not understand this interpretation of BURKITT, III et al., and it would appear to be contrary to BURKITT, III et al. itself. Figure 1 of BURKITT, III et al. is a "perspective view of a partially-installed preferred fiber optic cable assembly according to the invention". Figure 2 of BURKITT, III et al. provides a "cross-sectional view of the preferred fiber optic cable assembly taken about line 2-2 of FIG. 1". Both Figure 1 and Figure 2 of BURKITT, III et al. show the same preferred fiber optic cable assembly. Figure 1 shows a perspective view of the entire system, and Figure 2 shows a detailed view of the preferred fiber optic cable assembly of Figure 1 taken along line 2-2. One skilled in the art would clearly understand this.

The Examiner appears to be asserting that because the system level figure (Figure 1) does

not explicitly show a space between the elongated light source 12 and the light receiving cavity or lumen 28, that no space exists, despite having Figure 2, which clearly shows additional detail of the same preferred fiber optic cable assembly of Figure 1, and more specifically, that the bundle of fiber optic 12 only occupies about 55% of the cross-sectional area of the internal longitudinal passageway 28. It is unreasonable to attempt to use a more general figure to argue a feature does not exist (i.e. a gap), when a more detailed figure for the same embodiments exists and clearly shows that the feature (i.e. the gap) is present. Furthermore, it is a common engineering practice to look to more detailed figures to understand the detailed construction of a device, and not to look to more general drawings and assume that the details shown in the detailed drawings do not exist in the device.

Moreover, the general figure (Figure 1) only has a single line outlining the elongated light source 12 as it enters the tube 14, which if taken literally, would mean that there is absolutely no space or gap between the elongated light source 12 and the tube 14. However, this cannot be true because it would appear impossible to insert the elongated light source 12 into the tube 14 with no clearance, particularly for a length that corresponds to the perimeter of a swimming pool. That is, there must be some space or gap between the elongated light source 12 and the tube to facilitate such insertion. This space or gap is clearly shown in Figure 2, and it is improper to ignore Figure 2 and conclude from Figure 1 that no gap exists.

In an attempt to overcome this problem with BURKITT, III et al., the Examiner states that Applicant appears to have mistakenly took BURKITT, III et al. exemplary showing of **some** of the optical fibers forming the **whole** of the elongated light source 12, as showing the true shape of such elongated light source." However, there is nothing in BURKITT, III et al. that supports this position. That is, there is nothing in BURKITT, III et al. that suggests that only some of the optical fibers forming the whole of the elongated light source 12 are shown in Figure 1 or Figure 2. Applicant has reviewed BURKITT, III et al., and has not found any support for such a position. As such, it appears that the Examiner has made up this interpretation of BURKITT, III et al. out of whole cloth. For these and other reasons, claim 15 is believed to be

clearly patentable over BURKITT, III et al.

In paragraph 10 of the Final Office Action, the Examiner rejected claim 32 under 35 U.S.C. § 102(b) as being anticipated by BURKITT, III et al. Applicant respectfully disagrees. Claim 32 recites:

> 32. (previously presented) A light adapted for use with a boat, the light comprising:
>
> elongated light source means for emitting light rays; and
>
> an elongated bumper means for carrying the elongated light source means and for providing a bumper function for a boat during normal use of the boat, said elongated bumper means including means for allowing light rays from the elongated light source means to be emitted along at least a majority of the length of the elongated bumper means, the elongated bumper means further having a primary bumper surface that faces away from the boat, wherein the elongated light source means is situated between the primary bumper surface and the boat such that the primary bumper surface helps shield and protect the elongated light source means during normal use of the boat.

(Emphasis Added). In paragraph 12 of the Final Office Action, the Examiner states that "claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function" (emphasis original), citing *In re Schreiber*, 44 USPQ2d 1429. The Examiner also states that it has been held by the courts that apparatus claims cover what a device is, not what a device does, citing *Hewlett-Packard Co., v. Bausch & Lomb Inc.*, 15 USPQ2d 1525 (Fed. Cir. 1990). Because claim 32 recites elements in functional terms, the Examiner takes the position that the recited functional language can be ignored. Applicant believes this to be clear legal error and respectfully requests withdrawal of the rejection.

Claim 32 is a "means -plus-function" claim specifically authorized by 35 U.S.C. § 112, sixth paragraph. Claim 32 recites, for example, elongated light source means for emitting light rays, and an elongated bumper means for carrying the elongated light source means and for providing a bumper function for a boat during normal use of the boat. 35 U.S.C. § 112, sixth paragraph, recites:

> An element in a claim for a combination may be expressed as a means or step for performing a specified function ***without*** the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the

> corresponding structure, material, or acts described in the specification and equivalents thereof.

(emphasis added). As can readily be seen, 35 U.S.C. § 112, sixth paragraph, specifically authorizes that an element of a claim may be expressed as a means for performing a specified function without the recital of structure, material or acts in support thereof. Because claim 32 is believed to fall within 35 U.S.C. § 112, sixth paragraph, Applicant does not believe it is legally proper for the Examiner to ignore the functional language recited therein.

Notably, MPEP § 2181 states:

> When making a determination of patentability under 35 U.S.C. 102 or 103, past practice was to interpret a "means or step plus function" limitation by giving it the "broadest reasonable interpretation." Under the PTO's long-standing practice this meant interpreting such a limitation as reading on any prior art means or step which performed the function specified in the claim without regard for whether the prior art means or step was equivalent to the corresponding structure, material or acts described in the specification. However, in Donaldson, the Federal Circuit stated:
>
> > Per our holding, the "broadest reasonable interpretation" that an examiner may give means-plus-function language is that statutorily mandated in paragraph six. Accordingly, the PTO may not disregard the structure disclosed in the specification corresponding to such language when rendering a patentability determination.

One skilled in the boat bumper art would clearly recognize that BURKITT, III et al. does not provide an elongated bumper means for carrying the elongated light source means and for providing a bumper function for a boat during normal use of the boat. BURKITT, III et al. discloses a fiber optic cable assembly that mounts to an inner perimeter surface of a swimming pool or a spa to providing lighting around the perimeter of the swimming pool or spa (see, BURKITT, III et al., abstract). This application appears to be merely ornamental, and does not appear to provide or require any "bumper" function at all, let alone "providing a bumper function for a boat during normal use of the boat", as recited in claim 32. In fact, it is difficult to see any

need for a "bumper function" around the inside perimeter of a swimming pool or spa, as there would typically not be any objects in the swimming pool (e.g. people, inflatable inner tubes, etc.) that would require the swimming pool to include a bumper function around its inner perimeter.

Notably, when discussing durability, BURKITT, III et al. state: ["t]his arrangement also provides for increased durability and less likelihood that children will remove the tube from the track and damage the lighting system" (BURKITT, III et al., column 2, lines 43-46). As can be seen, and as far as durability is concerned, the types of things BURKITT, III et al. are worried about include children removing the tube from the track while playing in the swimming pool or spa, which is entirely different in scale from providing a bumper function for a boat during normal use of the boat, as recited in claim 32.

Nor is there anything in BURKITT, III et al. that would suggest that the fiber optic cable assembly of BURKITT, III et al. could providing a bumper function for a boat during normal use of the boat. In fact, given the apparent rather tenuous coupling between the tube and the track, with most of the tube outside of the track and having only the ends of the longitudinal members of the tube engaging certain limited parts of the L-shaped track (see Figure 2 of BURKITT, III et al.), it would appear that if the fiber optic cable assembly of BURKITT, III et al. were placed on a boat and subject to the kinds of abuse that a boat bumper is subject to during normal use, at a minimum the tube 14 would likely be pulled from the track 40, particularly since the kinds of abuse BURKITT, III et al. appears to be worried about include children removing the tube from the track while playing in the swimming pool or spa. Clearly, one skilled in the boat bumper art would not consider BURKITT, III et al. as being capable of providing a bumper function at all, let a alone a bumper function for a boat during normal use of the boat, as recited in claim 32. For these and other reasons, claim 32 is believed to be clearly patentable over BURKITT, III et al.

Rejections Under 35 U.S.C. § 103

In paragraph 13 of the Final Office Action, the Examiner rejected claims 1 and 3-9 under 35 U.S.C. § 103(a) as being unpatentable over BURKITT, III et al. in view of BELL. Applicant

respectfully traverses this rejection. Claim 1 recites:

> 1. (previously presented) A rub-rail assembly, comprising:
> a carrier having a back support, a first leg and a spaced second leg, wherein the first leg and the second leg extend from the back support to define a carrier cavity, and wherein the first leg and the second leg have terminating ends opposite the back support that define a gap that is part of the carrier cavity;
> an insert having a main body, a first leg and a second leg, the first leg adapted to provide an interference fit with the first leg of the carrier and the second leg adapted to provide an interference fit with the second leg of the carrier when the insert is installed in a seat position with the carrier; and
> the insert having a light receiving cavity or lumen extending lengthwise defined by side walls for receiving an elongated light source, the insert having a slit or opening along a length of the insert that extends from an outer surface of the insert and into the light receiving cavity or lumen to facilitate insertion and/or extraction of the elongated light source into/from the light receiving cavity or lumen, the slit or opening facing the carrier cavity when the insert is installed in the seat position, and wherein the side walls of the light receiving cavity or lumen are configured to retain the elongated light source relative to the insert even when the insert is separated from the carrier.

As can be seen, claim 1 recites an insert that that has a slit or opening along a length of the insert that extends from an outer surface of the insert and into the light receiving cavity or lumen to facilitate insertion and/or extraction of the elongated light source into/from the light receiving cavity or lumen. The Examiner acknowledges that BURKITT, III et al. does not disclose such a slit. However, the Examiner states that BELL shows a slit (citing Figure 4, reference number 110). The Examiner concludes that it would have been obvious to include the slit of BELL in the elongated member of BURKITT, III et al. to be able to easily remove the light source in the event that it needs service or replacement (citing BELL, column 3, lines 51-55). The Examiner further states that it would have been obvious to place such a slit on the side facing the elongated carrier for presenting a continuous and uniform output surface and for preventing the light source from being accidentally removed from the elongated member.

Applicant must respectfully disagree. For the Examiner's convenience, Figure 2 of BURKITT, III et al. and Figure 4 of BELL are reproduced below:

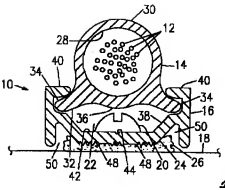
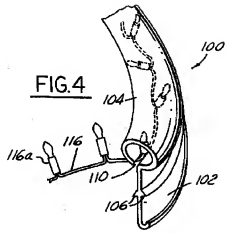


Fig. 2



BELL state:

> The illuminated landscape edging 100 is composed of a planar member 102 which is structured to be implanted into the ground and by a tubular member 104 which is structured to be located above ground. The planar member 102 is preferably provided with a medial ribbing 106 and also preferably provided with an end hook 108, both of which optionally taking on any form suitable for serving to anchor the planar member into the ground.

(BELL, column 2, lines 58-66). BELL further state that the sidewall of the tubular member 104 is provided with a slit 110 running its length in parallel alignment with the planar member 102, preferably located adjacent the planar member. (BELL, column 3, lines 6-9). BELL further state that the lighting string 116 is encapsulated by the tubular member 104, thereby protecting it from injury, and that in the event any of the lights 116a of the lighting string 116 need service, it is a simple matter to access the subject light via the slit 110 in the tubular member 104, and if needed, the slot 114. (Emphasis Added) (BELL, column 3, lines 48-55).

As can be seen, when installed, the planar member 102 extends into the ground and secures the illuminated landscape edging 100 to the ground. As shown in Figure 4 and other Figures of BELL, the slit 110 is positioned on the non-viewing side of the illuminated landscape edging 100 (thereby providing a continuous and uniform output surface on the viewing side), adjacent to the planar member 102 and above the ground, so that it is a simple matter to access the subject light via the slit 110 in the tubular member 104 to service the lighting string 116 after

the illuminated landscape edging 100 is installed in the ground. Clearly, it would not be a simple matter to service the lighting string 116 if the illuminated landscape edging 100 had to first be removed (i.e. dug up) from the ground.

If BELL were combined with Burkett as the Examiner suggests, BELL would suggest placing the slit 110 somewhere that is accessible from outside of the track 16 of BURKITT, III et al., such as shown below:

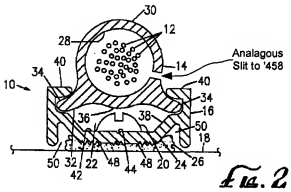


Fig. 2

This example slit arrangement would be consistent with the teachings of BELL. For example, this arrangement would make it a simple matter to access the fiber cable 12 of BURKITT, III et al. via the slit in the tube 14 to service the fiber cable 12 after the tube 14 has been installed in the track 16, without having to remove the tube 14 from the track (which is analogous to not having to remove the illuminated landscape edging 100 from the ground to service the lighting string 116). Nothing in BELL would suggest placing the slit of BELL on the side facing the elongated carrier of BURKITT, III et al., as the Examiner suggests, particularly since this would require that the tube 14 be removed from the track 16 (analogous to digging up the illuminated landscape edging 100 from the ground) before the fiber cable 12 could be serviced, which is contrary to the teachings of BELL and would not make it a simple matter to service the light source. Thus, and as can readily be seen, BELL would appear to actually teach away from the arrangement proposed by the Examiner.

The Examiner also states that it would have been obvious to place the slit of BELL on the

side facing the elongated carrier of BURKITT, III et al. for "preventing the light source from being accidentally removed from the elongated member". However, and as noted above, BELL state that the lighting string 116 is encapsulated by the tubular member 104, thereby protecting it from injury. There is nothing in BURKITT, III et al. or BELL that would suggest that by placing the slit of BELL on the side facing the elongated carrier of BURKITT, III et al. would in any way help "prevent the light source from being accidentally removed from the elongated member", particularly since BELL teaches that his construction already adequately protects the lighting string 116.

As noted in MPEP § 2143.01 III, "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) (emphasis added), and "although a prior art device may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." 916 F.2d at 682, 16 USPQ2d at 1432.). See also *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992) (emphasis added). In the present case, there is no suggestion or motivation whatsoever in either BELL or BURKITT, III et al. to place the slit of BELL on the side facing the elongated carrier of BURKITT, III et al., as the Examiner suggests. In fact, and as detailed above, BELL would appear to actually teach away from such an arrangement. Moreover, placing the slit of BELL on the side facing the elongated carrier of BURKITT, III et al. would appear to cut the major support structure between the opposed edges 34 of BURKITT, III et al., rendering the structure of BURKITT, III et al. even more flimsy, and in Applicant's view, likely rendering BURKITT, III et al. unsuitable for one of it's intended purposes (e.g. help prevent children removing the tube from the track while playing in the swimming pool or spa).

In paragraph 41 of the Final Office Action, the Examiner states that Applicant is using "teaching away" in a much broader sense than is legally acceptable. Perhaps so, but Applicant's arguments make it clear that there would be no actually teaching, suggestion or motivation to place the slit of BELL on the side facing the elongated carrier of BURKITT, III et al. The burden

is on the Examiner to clearly set forth a credible teaching, suggestion or motivation to make the claimed combination in order to establish a prima facie case of obviousness.

In paragraph 42 of the Final Office Action, the Examiner stated motivation for forming the slit of BELL in the side facing the elongated carrier of BURKITT, III et al. is to present a continuous and uniform output surface and for preventing the light source from being accidentally removed from the elongated carrier. In paragraph 41 of the Final Office Action, the Examiner also states that "it would have been obvious to one of ordinary skill in the art to provide such slit to the elongated member of BURKITT, III et al., to enable the light source of BURKITT, III et al. to be easily removed for service or replacement, as explicitly suggested by BELL (see column 3, lines 51-55).

However, these stated motivations do not address the required specific motivation to place the slit of BELL in the side facing the elongated carrier of BURKITT, III et al., as recited in claim 1. As detailed above, the arrangement presented above, and duplicated below:

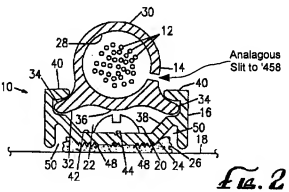


Fig. 2

would:

- *present a continuous and uniform output surface* - as shown in Figure 4 and other Figures of BELL, the slit 110 is positioned on the non-viewing side of the illuminated landscape edging 100, thereby providing a continuous and uniform output surface on the viewing side;

- *prevent the light source from being accidentally removed from the elongated carrier* (as noted above, BELL state that the lighting string 116 is encapsulated by the tubular member 104, thereby already protecting it from injury). There is nothing in BURKITT, III et al. or BELL that would suggest placing the slit of BELL on the side facing the elongated carrier of BURKITT, III et al. would in any way help "prevent the light source from being accidentally removed from the elongated member", particularly since BELL teaches that his construction already adequately protects the lighting string 116; and
- *enable the light source to be easily removed for service or replacement* (the above shown arrangement would make it a simpler matter [simpl***er*** than the Examiner's arrangement] to access the fiber cable 12 of BURKITT, III et al. via the slit in the tube 14 to service the fiber cable 12 after the tube 14 has been installed in the track 16, without having to remove the tube 14 from the track, which is analogous to not having to remove the illuminated landscape edging 100 from the ground to service the lighting string 116. Nothing in BELL would suggest placing the slit of BELL on the side facing the elongated carrier of BURKITT, III et al., as the Examiner suggests, particularly since this would require that the tube 14 be removed from the track 16, analogous to digging up the illuminated landscape edging 100 from the ground, before the fiber cable 12 could be serviced, which is contrary to the teachings of BELL).

As can readily be seen, the Examiner's stated motivation appears to be too general in nature to support an obviousness rejection of the specific claimed combination (i.e. relative to the specific claim language recited in claim 1). There are many places to provide a slit in the tube 14 of BURKITT, III et al., and in order to establish a prima facie case of obviousness, the Examiner must provide a motivation for combining the references in the specific manner recited in the claim, which Applicant believes that Examiner has failed to do.

In paragraph 18 of the Final Office Action, and with respect to claim 4, the Examiner states that claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. The Examiner states that claim 1 does not positively recite the

elongated light source, and claim 4 merely requires a majority of the elongated light source as being positioned inside the carrier cavity. In response, and in the spirit of cooperation, claim 4 has been amended as follows to positively recite the elongated light source:

> 4. (currently amended) The rub-rail assembly of claim 1 further comprising the elongated light source, wherein at least a majority of the elongated light source is situated inside the carrier cavity when the insert is installed in the seat position.

Even so, the Examiner states that if the elongated light source were positively recited, arranging the structure of BURKITT, III et al. to receive at least a majority of the elongated light source inside the carrier cavity would have been obvious to one of ordinary skill in the art since it has been held that rearranging parts of a prior art structure involves only routine skill in the art. The Examiner states that in this case, positioning the elongated light source of BURKITT, III et al. so that at least a majority of such elongated light source is inside the carrier cavity when the insert is installed in the seat position would not change the operation or function of the patented device.

Applicant respectfully disagrees. In contrast to the ornamental swimming pool device of BURKITT, III et al., claim 4 recites a rub-rail assembly. The described configuration recited in claim 4 is not merely rearranging parts, as the Examiner appears to be suggesting, but rather is significant in that it provides additional functionality. Claim 4 recites the rub-rail assembly of claim 1 further comprising the elongated light source, wherein at least a majority of the elongated light source is situated inside the carrier cavity when the insert is installed in the seat position. Situating at least a majority of the elongated light source inside the carrier cavity when the insert is installed in the seat position *provides extra protection to the elongated light source, which can be significant in rub-rail applications*. Clearly, the configuration of claim 4 would change the operation relative to the swimming pool device of BURKITT, III et al. (where most of the tube and light source are outside of the track and have only the ends of the longitudinal members of the tube engaging certain limited parts of the L-shaped track) *by providing additional protection to the elongated light source in bumper type applications*. For these additional reasons, claim 4 is believed to be clearly patentable over BURKITT, III et al. in view of BELL.

In paragraph 19 of the Final Office Action, and with respect to claim 9, the Examiner states that it would have been obvious to one of ordinary skill in the art to use a non-transparent material of the elongated member of BELL in the insert of the patented device of BURKITT, III et al. to provide the desired illumination effect, as per the teachings of BELL. The Examiner appears to be relying on column 3, lines 64-68 of BELL as suggesting the insert having a transparent material on the viewing side of the rub-rail assembly, and further having a substantially non-transparent material also on the viewing side of the rub-rail assembly (see paragraph 16 of the Final Office Action).

In paragraph 31 of the Final Office Action and with respect to claim 21, the Examiner cites column 2, lines 66-67 of BELL as suggesting an insert having an at least partially transparent material that extends from the light receiving cavity or lumen to an outer surface of the insert on a viewing side of the rub rail assembly, and to column 3, lines 64-68 of BELL as suggesting the insert further having a substantially non-transparent material also on the viewing side of the rub-rail assembly.

Applicant must respectfully disagree. Column 3, lines 64-68 of BELL states:

> However, as shown in FIG. 6, an alternative form of the illuminated landscape edging 100' may utilize a tubular member 104' that is conventionally opaque, but is provided with a plurality of discrete holes 122 running periodically placed along its length through which the illumination from the lighting string 116 shines.

As can readily be seen, BELL teaches that the sidewall of the tubular member 104 is constructed of a light passable material in one embodiment (see, BELL, column 2, lines 66-67), OR alternatively, the sidewalls of the tubular member 104' are made from an opaque material with discrete holes 122 periodically placed along its length through which the illumination from the lighting string 116 shines. That is, BELL actually teaches one embodiment where the tubular member 104 is made from a transparent material, and a different embodiment where the tubular member 104' is made from an opaque material with discrete holes 122 periodically placed along its length. ***BELL does not appear to teach using both a transparent material and an opaque material in the same embodiment, and in particular, using a transparent material and an***

opaque material on the viewing side of a rub-rail assembly, as the Examiner appears to be suggesting.

In contrast, claim 9, which is dependent from claim 8, recites:

> 8. (previously presented) The rub-rail assembly of claim 1 wherein the main body of the insert includes a transparent or semi-transparent material that extends from the light receiving cavity or lumen to an outside surface of the main body on a viewing side of the rub-rail assembly when the insert is installed in the seat position.
>
> 9. (previously presented)The rub-rail assembly of claim 8 wherein the main body also includes a non-transparent or substantially non-transparent material on the viewing side of the rub-rail assembly when the insert is installed in the seat position.

Clearly, there is nothing in the cited passages of BELL that suggest providing a transparent or semi-transparent material that extends from the light receiving cavity or lumen to an outside surface of the main body on a viewing side of the rub-rail assembly AND a non-transparent or substantially non-transparent material also on the viewing side of the rub-rail assembly, as recited in claim 9. Instead, the cited passages of BELL teach providing either a light passable material (see, BELL, column 2, lines 66-67) , or alternatively, an opaque material with discrete holes 122 (see, BELL, column 3, lines 64-68). Thus, if anything, BELL would suggest using a light passable material in BURKITT, III et al. OR alternatively, an opaque material with discrete holes 122 periodically placed along its length. However, this is not what claim 9 states. The Examiner appears to be misinterpreting the teachings of BELL when making this rejection.

Similarly, claim 21 recites:

> 21. (previously presented)A rub-rail assembly, comprising:
> a carrier having a back support, a first leg and a spaced second leg, wherein the first leg and the second leg extend out from the back support to form a carrier cavity;
> an insert having a main body, a first leg and a second leg, the first leg adapted to provide an interference fit with the first leg of the carrier and the second leg adapted to provide an interference fit with the second leg of the carrier when the insert is installed in a seat position with the carrier; and

the insert having a light receiving cavity or lumen extending lengthwise for receiving an elongated light source, the insert further having an at least partially transparent material that extends from the light receiving cavity or lumen to an outer surface of the insert on a viewing side of the rub-rail assembly, and further having a substantially non-transparent material also on the viewing side of the rub-rail assembly.

Clearly, there is nothing in the cited passages of BELL that suggest having an at least partially transparent material that extends from the light receiving cavity or lumen to an outer surface of the insert on a viewing side of the rub-rail assembly, and further having a substantially non-transparent material also on the viewing side of the rub-rail assembly, as recited in claim 21. For these and other reasons, claims 9 and 21 are believed to be clearly in condition for allowance.

In paragraph 20 of the Final Office Action, the Examiner rejected claims 10-11 under 35 U.S.C. § 103(a) as being unpatentable over BURKITT, III et al. in view of BELL. For similar reasons to those given above with respect to claim 1, as well as other reasons, dependent claims 10-11 are believed to be clearly patentable over BURKITT, III et al. in view of BELL.

In paragraph 23 of the Final Office Action, the Examiner rejected claims 16-17 under 35 U.S.C. § 103(a) as being unpatentable over BURKITT, III et al. in view of BELL. For similar reasons to those given above with respect to claims 1 and 15 above, Applicant believes that claims 16-17 are clearly patentable over BURKITT, III et al. in view of BELL.

In paragraph 28 of the Final Office Action, the Examiner rejected claims 21 and 23-25 under 35 U.S.C. § 103(a) as being unpatentable over BURKITT, III et al. in view of BELL. Applicant respectfully disagrees. In paragraph 30, the Examiner acknowledges that BURKITT, III et al. fails to disclose an insert that has a substantially non-transparent material also on the viewing side of the rub-rail assembly, and as detailed above, BELL fails to disclose the use of an at least partially transparent material AND a substantially non-transparent material in the same embodiment. *Thus, the combination of BURKITT, III et al. and BELL must necessarily fail to render claim 23 obvious.*

In addition, claim 23 recites:

23. (currently amended) The rub-rail assembly of claim 21 wherein

the at least partially transparent material and the substantially non-transparent material are provided ~~configured~~ such that light is only allowed to escape from the elongated light source on the viewing side of the rub-rail assembly along an arc with a center in the light receiving cavity or lumen that spans less than 180 degrees.

(Emphasis Added). The Examiner cites to Figure 2 of BURKITT, III et al. as suggesting the emphasized feature. Figure 2 of BURKITT, III et al. is reproduced below with annotations added:

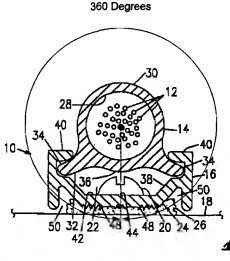


Fig. 2

As can readily be seen, the tube 14 of BURKITT, III et al. clearly allows that the light to escape from the elongated light source along an arc that spans greater than 180 degrees, and in fact, 360 degrees. For these and other reasons, claim 23 is believed to be clearly patentable over BURKITT, III et al. in view of BELL.

Claim 24 recites:

24. (previously presented) The rub-rail assembly of claim 21 wherein the elongated light source has a size and shape, and wherein the light receiving cavity or lumen is defined by a cavity or lumen wall that, in cross-section, has a shape and size to accommodate the size and shape of the elongated light source and so that the elongated light source fills or substantially fills the light receiving

cavity or lumen as defined by the cavity or lumen wall.

For reasons similar to those detailed above with respect to claim 15, as well as other reasons, claim 24 is believed to be clearly patentable over BURKITT, III et al. in view of BELL.

Finally, with respect to claim 25, for similar reasons to those detailed above with respect to claim 1, as well as other reasons, claim 25 is believed to be clearly patentable over BURKITT, III et al. in view of BELL.

In view of the foregoing, it is believed that all pending claims 1, 3-17, and 21-32 are in condition for allowance. Reexamination and reconsideration are respectfully requested. If the Examiner believes it would be beneficial to discuss the application or its examination in any way, please call the Applicant at (612) 359-9348.

Respectfully submitted,

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